

IN THE DRAWING:

Applicant proposes to amend the drawings in accordance with the enclosed annotated marked-up drawing sheets. Figs. 1, 2, 3, 3A, 4, and 6 are affected by this proposed amendment.

REMARKS

Favorable reconsideration of the application is most earnestly solicited in view of the following remarks.

The application, as originally filed, contained claims 1-18. Claims 1-18 were rejected in the outstanding Office action, dated January 13, 2005. Claims 1-18 remain in the application, unamended. Claim 19 has been added to the application.

Claims 1-9, 13 and 14 were rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Tisbo (Des. 385,920) in view of Sato et al. (US 3,927,767), Polhemus et al. (US 4,768,298), and Mayo (US 5,727,766). Applicant respectfully traverses this rejection for the reasons discussed below.

Tisbo (which was assigned to Custom Plastics, Inc.) discloses an accessory tray made from a single molded piece of plastic. Sato et al. discloses a package assembled from a single corrugated sheet folded upon itself to create a compartment for enclosing an item for shipment. Sato et al. is not concerned with accessory trays, as in Tisbo, or with a desk organizer tray of the claimed invention. A shipping package is not the same as or analogous to the art of accessory trays or desk organizer trays. Tisbo is not concerned with any fabrication technique other than plastic molding. Tisbo strongly suggests that the tray be fabricated as a unitary article, not from a "plurality of superimposed board members" as claimed in claims 1-9, 13 and 14. There is no motivation in Tisbo to look to other tray-fabrication techniques, especially those that require multiple parts. Assuming, *arguendo*, that there is a motivation to consider alternative fabrication techniques for desktop trays, one of ordinary skill in the art would not look to the shipping package trade to find an answer. It is only through hindsight gained from Applicant's invention that one might seek out Sato et al. and combine it with Tisbo. Accordingly, it is respectfully submitted that the combination of Tisbo and Sato et al. is improper to form a rejection of claims 1-9, 13 and 14.

The other secondary references -- Polhemus et al. and Mayo -- do not offer a motivation or suggestion to alter the Tisbo tray. The tray elements in Polhemus et al. all appear to be unitary articles. And, the tray compartment in Mayo is made from a single piece 14.

Furthermore, each of the claimed plurality of board members contains "a hole pattern." Sato et al. has a bottom board member without a hole pattern. Thus, one would have to remove this bottom board member to combine Sato et al. with Tisbo, so that the bottom of the Tisbo tray

can be utilized. Such a radical modification of Sato et al, in order to combine it with Tisbo, is unlikely by one of ordinary skill in the art without the teachings of the present invention.

Therefore, in view of the above discussion, it is respectfully requested that the rejection of claims 1-9, 13 and 14 be withdrawn and said claims be allowed.

The Office argues that Polhemus et al. teaches the claimed attachment means. However, it is clear that Polhemus et al. does not teach or suggest that such an attachment be "applied to the board member of said extension member," as claimed in claim 1. In fact, Polhemus et al. suggests another location, i.e., on the side of the tray portion. Tisbo, Sato et al, or Mayo offer no guidance as to the claimed location of the attachment means. Again, such location can only be determined after viewing the claimed invention.

Mayo is cited for allegedly teaching that an adhesive strip was an equivalent structure known in the art for joining elements of desktop articles. However, Mayo merely teaches that double-sided tape may be used to fabricate a binding on a single article, i.e., a desk pad. There is no suggestion in Mayo that an attachment means be employed for attaching one article (i.e., a desk pad) to another article (i.e., the combined tray portion and extension portion), as required by the claims of the present application. Thus, Mayo would not have been looked to as an equivalent means to the attachment clip of Polhemus et al., for attaching separate desktop articles. Accordingly, it is improper to combine Mayo with the other references to reject the claims of the present application.

In view of the above remarks, it is respectfully submitted that claims 1-9, 13 and 14 are patentable over the art of record and in condition for allowance.

Claims 10 and 12 were rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Tisbo-Sato-Polhemus-Mayo as applied to claim 1, and further in view of Tracy et al. (US 3,744,435). Applicant respectfully traverses this rejection for the reasons presented above with respect to claims 1-9, 13 and 14. Accordingly, it is respectfully submitted that claims 10 and 12 are patentable and in condition for allowance.

Claim 11 was rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Tisbo-Sato-Polhemus-Mayo-Tracy as applied to claim 10, and further in view of McMullen (US 1,331,995). Applicant respectfully traverses the rejection for the reasons presented above with

respect to claims 1-9, 13 and 14. Accordingly, it is respectfully submitted that claim 11 is patentable and in condition for allowance.

Claims 15-18 were rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Tisbo-Sato-Polhemus-Mayo as applied to claim 1, and further in view of McMullen. Applicant respectfully traverses this rejection. Claims 15-17 are clearly patentable and in condition for allowance, for the reasons given with respect to claims 1-9, 13 and 14.

Claim 18 is a method claim. It specifically recites a method for assembling a desk pad organizer system, comprising the steps of:

- (a) providing a desk pad;
- (b) providing a desk organizer tray including a tray portion, an extension portion, and an adhesive element applied to the extension portion; and
- (c) applying the desk pad to the adhesive element on the extension portion and locating the desk pad adjacent to the tray portion.

The Office action merely states that claim 18 is met by presentation. No further explanation of the rejection is given. A careful review of Tisbo, Sato, Polhemus, Mayo, and McMullen does not reveal expressly or by implication (or by "presentation") the method steps recited in claim 18. Tisbo-Sato-Polhemus-Mayo have been discussed. McMullen states that a calendar 17 may be pasted onto the top surface of pocket 12 (col. 2, lines 82-86); however, there is no teaching in McMullen of the step of applying a desk pad to an adhesive element on an extension portion of a desk organizer tray, as claimed in claim 18. Accordingly, it is respectfully submitted that claim 18 is patentable over the art of record and in condition for allowance.

Claim 19 has been added to the application. Claim 19 is a dependent claim, depending from claim 18. Claim 19 introduces the additional method step of (d) removing a protective substrate from the adhesive element before applying the desk pad to the adhesive element. It is respectfully submitted that claim 19 is patentable over the art of record and in condition for allowance. Support for claim 19 is found in paragraph [0025] as originally filed. Applicant is proposing to amend the drawings to show the claimed protective substrate. Filed herewith are annotated marked-up drawing sheets to show the proposed drawing amendments. Figs. 1, 2, 3, 3A, 4, and 6 are affected by the proposed amendment, as indicated. If the Examiner approves the drawing amendments, then Applicant will file new formal drawings. The amendment to paragraph [0025] of the specification results from and follows the proposed drawing

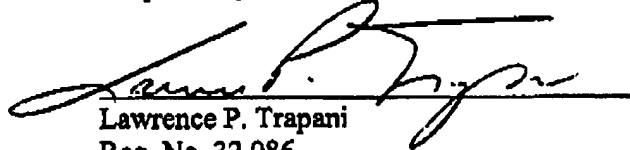
amendments. No new matter has been added by the introduction of claim 19, the proposed drawing amendments, or the amendment to paragraph [0025].

The additional references cited by the Examiner, but not relied upon, have been reviewed. Applicant's own design patent, Des 497,953, is not prior art to the present application. It is submitted that the other references are no more relevant than those submitted by Applicant or those relied upon by the Examiner.

Early and favorable consideration of the application, as amended, is most earnestly solicited. If for any reason the Examiner feels that consultation with Applicant's attorney will be helpful, he is invited to call Applicants' attorney for an interview.

Respectfully submitted,

4/13/05
Date


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